

REMARKS

Claims 34-39 are currently pending in the current application. Each of claims 34-39 stands rejected by the September 25, 2009 Office Action. Claims 34-36 are amended by the present response. Claims 34-36 are independent claims, and claims 37-39 depend, either directly or indirectly, from claim 36. Applicants respectfully request reconsideration of the Application, in light of the following remarks.

Rejection of Claim 34 under 35 U.S.C. §112

Claim 34 stands rejected under 35 U.S.C. 112, as failing to comply with the written description requirement. Explaining this rejection, the Office Action states that “[t]he specification does not provide support for providing the portal after the offering by a second system of a second party **or** the buyer can search for promotion from the first party after the offering by the second system of a second party.” (See Office Action at p. 3; emphasis in original.) Applicants respectfully traverse this rejection at least for the reasons set forth in previous submissions. In any event, in light of amendments to claim 34 discussed below in connection with the §102 rejection, which have removed the “after the offering by a second system of a second party” language, Applicants respectfully submit the §112 rejection is rendered moot.

Claim 34 also stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See Office Action at p. 3.). The Office Action identifies the language “wherein the portal is provided after the offering by a second system of a second part [sic] for sale online at the sales price.” (See *id.*) While Applicants respectfully traverse this rejection, as also mentioned above, Applicants respectfully submit this rejection has been mooted in light of the below described amendment to claim 34. Applicants respectfully request the withdrawal of the rejection of claim 34 under 35 U.S.C. 112.

Rejection of Claim 34-35 as being anticipated by Meyer

Applicants begin by addressing the rejection of claim 34 under 35 U.S.C. §102(e) as being anticipated by Meyer *et al.*, U.S. Patent No. 6,915,271 (hereinafter “Meyer”). Applicants respectfully traverse the rejection as set forth by the Office Action, at least for similar reasons as

discussed in previous submissions. Nevertheless, Claim 34 is amended by the present response to clarify the presently claimed subject matter and to help expedite prosecution of certain aspects of the presently claimed subject matter. Namely, claim 34 is amended by the present response to recite that the offering, by a second system of a second party, includes **“wherein the item for sale can be identified by a customer,”** and that a portal is provided containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale **after the customer has identified the item for sale.** Support for this amendment may be found in the Specification, for example, at p. 15, lines 11-18 (**“After selecting the desired items into a shopping cart,** the customer invokes a rebate and coupon button on a screen...if any items in the shopping cart are not specific enough to unambiguously identify a manufacturer, **the system 15 returns coupons for multiple manufacturers of similar products for the customer to choose from.”**; emphasis added) (*See also* Specification, e.g., at p. 13, lines 4-8: “...the customer would retrieve one or more coupons and rebates for one or more products that the customer plans to purchase, by browsing through several categories of products presented by the system for online sales with automatic rebate and coupon redemption 15. The rebates and coupons for products are also located by searching for them via a searching interface.”)

Applicants respectfully submit that the “buy now” feature of the relied upon portion of Meyer does not disclose such a portal wherein a customer can search for a promotion from the first party associated with the item for sale after the customer has identified the item for sale. Applicants respectfully submit that to the extent an item is argued to be identified by a customer in the cited portion of Meyer, that no subsequent searching for promotions is provided for. For at least the reasons discussed above, as well as in previous submissions, Applicants respectfully submit that Meyer does not anticipate claim 34, and that claim 34 is allowable.

Next, Applicants turn to the rejection of claim 35. Claim 35 is amended to correct minor typographical errors. Claim 35 expressly requires that the first party and the second party are different, as claim 35 recites “offering, by a second system of a second party, an item for sale online at a sales price amount,” where the item for sale has associated with it by the second system of the second party “a promotion from the first party.” Claim 35 also recites “receiving, by the second system, an online purchase request,” “responding, by the second system, to the online purchase request by collecting from the buyer...”, and “causing, by the second system,

shipment by the second party...” As such, the party which the promotion is from (the first party) is different from the party offering an item for sale online at a sales price, receiving an online purchase request, responding to the online purchase request by collecting a purchase amount, and shipping the item. In contrast, the Office Action expressly relies upon Fig’s. 33 and 35 and “\$5 off, Free Beanie Baby with Toy Purchases etc.” as teaching “...a promotion from the first party, the promotion having a promotion amount.” The “\$5 off Windsor Mugs” is a promotion from Target. The web page of Fig. 33 provides no price or offer to sell, but merely a link to “Buy now from Target.” Thus, to the extent that the promotion of Fig. 33 is argued to teach any party offering an item for sale, it is the same party from which the promotion comes, and not the party that, for example, has associated the promotion with it. Similarly, the “Free Beanie Baby with Toy Purchase” is a promotion from Holt, and any potentially arguable offer from sale comes from Holt (i.e. “Buy now from Holt Online.”) Claim 35, however, expressly requires that the party offering the item for sale online at a sales price (the second party) is different from the party which the promotion is from (the first party). Furthermore, Applicants respectfully submit that the “Buy Now” button relied upon by the Office Action does not display a price and therefore cannot teach offering an item for sale online at a sales price amount (with the item for sale also having associated with it, by the second system, a promotion from the first party) as fully set forth by claim 35. For at least the above reasons, as well as those discussed in previous submissions, Applicants respectfully submit that Meyer does not anticipate claim 35, and that claim 35 is allowable.

Rejection of Claims 36-39 as being anticipated by Meyer

Claim 36 and its dependent claims stand rejected as being unpatentable over Meyer in view of various other references. As an initial matter, claim 36, similar to claim 35, expressly recites that the first party (which the promotion is from) and the second party (which offers an item for sale online) are different. Further, the Office Action relies solely upon Meyer as teaching the common aspects shared between claim 35 and claim 36. Applicants respectfully submit that the additionally cited references do not remedy the above shortcomings in the disclosure of Meyer, and that claim 36 is allowable for similar reasons as those discussed above with respect to claim 35.

Further, claim 36 also recites, *inter alia*, “...wherein the item has been acquired by the second party from the first party...” The Office Action asserts that Meyer teaches this aspect of claim 36 at col. 40 line 67 to col. 41 line 2. (See Office Action at p. 6.) The cited portion of Meyer reads as follows: “...purchasing the goods or service, which may be the same site one is on, or at a different Web location, or corresponding to an offline merchant that does not have a Web site.” Such a teaching is silent with respect to the item having been acquired by the second party from the first party. For example, an “offline merchant,” even if argued to have acquired the item, cannot be the second party, because the second party offers the item for sale online. An “offline” merchant by definition would not offer the item for sale **online**. Further, a mere teaching of different sites that goods or services may be purchased from does not teach a second party having acquired the item as required by claim 36. For example, a site offering an item may not have yet acquired the item, and may only acquire the item later, or may not ever acquire the item at all.

For at least the above discussed reasons, as well as those given in previous submissions, Applicants respectfully submit that the cited references, either alone or in combination, do not teach, suggest, or otherwise render obvious the subject matter of claim 36 or any of its dependent claims; that the Office Action does not present a *prima facie* case of obviousness for those claims, and that those claims are allowable.

Conclusion

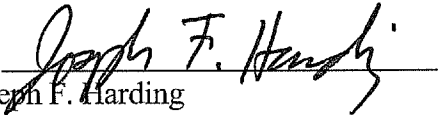
In general, the Office Action makes various statements regarding the pending claims and the cited reference that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicants believe that the pending claims are allowable. Should the Examiner disagree or have any questions regarding this submission, Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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